IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Gentz et al.	Docket No.: PF454P1
Application No.: 09/518,931	Confirmation No.: 7173
Filed: March 3, 2000	Art Unit: 1646
For: Tumor Necrosis Factor Receptors 6 Alpha & 6 Beta	Examiner: E. B. O'Hara

RESPONSE TO THE DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

MS Office of Patent Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

On October 1, 2007, the Commissioner for Patents denied Applicants Request for Reconsideration of Patent Term Adjustment. Because this decision was based upon an incorrect reading of applicable statutes and ignores guidance issued by the United States Patent and Trademark Office, Applicants respectfully request that the Commissioner withdraw its previous decision and provide a Patent Term Adjustment of 1043 days.

Period of Adjustment of Patent Term due to Examination Delay under 37 C.F.R. §1.702

On July 17, 2001, the Examiner issued a Final Rejection of the present Application. On November 20, 2001, Applicants responded to the Final Rejection by amending the claims and traversing the rejection. On January 17, 2002, the Examiner issued a communication to Applicants informing them that the amendments had been entered and all rejections previously presented had been withdrawn. A Notice of Allowance did not issue, however. Instead, the Examiner suspended prosecution pending resolution of a third party interference. Examination of the Application resumed on May

9, 2005, when the Examiner re-opened prosecution and entered new rejections under 35 U.S.C. §102 and §112. Ultimately, Applicants overcame all stated grounds for rejection and a Notice of Allowance issued on July 12, 2006.

After issuance, Applicants sought Patent Term Adjustment to correct an error in the Applicants favor, whereby the Office considered overlapping periods in their calculations. Applicants requested a Patent Term Adjustment of 1020 days. The Office instead concluded that Applicants were entitled to only 622 days. Applicants subsequently sought reconsideration of the Office's decision on Patent Term Adjustment, requesting a Patent Term Adjustment of 1043 days, the 1020 days initially petitioned for plus the uncontested 23 days of delay between the date four months after payment of the issue fee and the issuance of the patent. The Office denied this request.

The arguments for these adjustments is laid out in the initial Application for Patent Term Adjustment and the Reconsideration request, and will not be repeated in full in this paper. However, to summarize, Applicants sought in their Request for Reconsideration a Patent Term Adjustment to cover the time period between the filing of their November 20, 2001 response and the paper mailed by the Office on May 9, 2005, resuming prosecution. The requested Patent Term Adjustment was 1043 days. The Office denied this request, finding that the communication mailed January 17, 2002, constituted an Office Action within the meaning of 35 U.S.C. §154(b)(1)(A)(ii) and 37 C.F.R. §1.702(a)(2). Decision on Request for Reconsideration of Patent Term Adjustment ("the Decision"), page 3. The Office also found that no additional adjustment was due for the time period after the suspension was lifted because an action was taken within four months of the alleged lifting of the suspension. *Id.*

The issues for resolution in this petition are: (1) whether the Letter Regarding Suspension mailed by the Examiner on Jan 17, 2002, complied with the requirements imposed by 35 U.S.C §154(b)(1)(A)(ii), 35 U.S.C. §132, 37 C.F.R. §1.702(a)(2) and 37 C.F.R. §1.703(a)(3) and (2) whether the time period between Jan 8, 2005, when the suspension was arguably removed from the Application, and May 9, 2005, when the Examiner reopened prosecution, should be included in the Patent Term Adjustment.

The Examiner's Communication of January 17, 2002 did not Satisfy the Requirements Imposed by 35 U.S.C. §154(b)(1)(A)(ii), 35 U.S.C. §132, 37 C.F.R. §1.702(a)(2) and 37 C.F.R §1.703(a)(3)

The purpose of Patent Term Adjustment is to grant Applicants additional patent protection commensurate with the length of time an Application was pending in the patent office due to factors beyond an applicant's control. Unfortunately, the Office's Decision on Request for Reconsideration of Patent Term Adjustment runs contrary to this goal, i.e., the term of Applicants' patent rights were limited by delays in prosecution that Applicants could not have prevented through diligent action.

Pursuant to 35 U.S.C §154(b)(1)(A)(ii), Patent Term Adjustment is guaranteed if:

> The issue of an original patent is delayed due to the failure of the Patent and Trademark Office to . . . respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken.

37 C.F.R §1.702(a)(2) recites:

> The term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to . . . [r]espond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken[.]

Pursuant to 37 C.F.R. §1.703(a)(3), the period of adjustment under §1.702(a) includes:

> The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with §1.113(c)

> was filed and **ending on the date of mailing of either an action under 35 U.S.C. 132**, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

As a preliminary matter, the Office contends that Applicants filed a reply under 35 U.S.C §132 on November 20, 2001. Applicants respectfully disagree. 35 U.S.C. §132 provides the law by which **an Examiner** must conduct prosecution. An Applicant cannot respond under 35 U.S.C. §132, based on the language of the statute. Responses to Office Actions by an Applicant are provided in other sections of the Patent Regulations, namely 37 C.F.R. §1.111 and §1.113.

Irregardless, pursuant to 37 C.F.R §1.702(a)(2) and 37 C.F.R. §1.703(a)(3) **the Office** must issue a **response under 35 U.S.C. §132** not later than four months after the date on which a reply was filed. To qualify as an action under §132, an Examiner's Office Action must reject a claim, state an objection, or require further action by Applicants:

> Notice of Rejection; reexamination
> (a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention . . . .

See 35 U.S.C. §132.

Contrary to the Office's assertion, the Examiner's communication of January 17, 2002 did not satisfy any requirement under 35 U.S.C §132; the filing did not reject a claim, object to any portion of the application, or require further action by Applicants. Thus, the January 17, 2002 communication may not serve to limit the scope of Patent Term Adjustment due to Applicants.

Moreover, the MPEP provides clear guidance on the issue of when an Office Action may be considered to have rejected a claim, stated an objection, or required further action. This guidance is in direct conflict with the Office's ruling in the Decision. According to the MPEP, an action or notice may not be deemed a rejection, objection or other request if it "does not require a reply to that notice to continue the processing and examination of an application." *See* MPEP §2732 (at 2700-17, first paragraph of second column) (interpreting language that is identical to that found in 35 U.S.C. §132). Consequently, neither the Applicants' submission on November 20, 2001, nor the Examiner's Letter Regarding Suspension mailed on January 17, 2002, falls within the language contemplated by 35 U.S.C. §154(b)(1)(A)(ii), 35 U.S.C. §132, or 37 C.F.R. §1.702(a)(2), as alleged by the Office.

Additional support for Applicants interpretation can be found in 37 C.F.R. §1.703(a)(3), which defines the period of Patent Term Adjustment to include any period in excess of four months between the filing of a reply pursuant to §1.113(c) and the *mailing of an action under 35 U.S.C. §132* or a notice of allowance, whichever occurs first. Clearly, 37 C.F.R. §1.703(a)(3) defines the termination of a period of Patent Term Adjustment under 37 C.F.R. §1.702(a) by the mailing of an action Office Action under 35 U.S.C. §132. Thus, it is the Examiner's response under 35 U.S.C. §132 which defines the period of Patent Term Adjustment, and not that of the Applicant.

Based upon the foregoing, and pursuant to the express language of 35 U.S.C. §154(b)(1)(A)(ii), 35 U.S.C. §132, 37 C.F.R. §1.702(a)(2), and 37 C.F.R. §1.703(a)(3), the Examiner's January 17, 2002 communication may not serve to limit Applicants' right

to Patent Term Adjustment. Accordingly, Applicants' respectfully request reconsideration of the Office's previous decision denying Applicants a full Patent Term Adjustment.

Patent Term Adjustment for the Time Period that Examination was Suspended

Applicants maintain that based on the arguments recited above, the instant application is entitled to a Patent Term Adjustment through the mailing on May 9, 2005 of the first Office Action after prosecution was suspended. However, Patent Term Adjustment is also justified on other grounds.

The Examiner took the full four months allowable under 37 C.F.R. §1.702 to issue the January 17, 2002 communication stating that all claims were in condition for allowance. Examination was then suspended pending resolution of a third party interference. At this point Applicants could perform no act which would further examination. Then, after resolution of the third party interference, the Examiner took another four month before it reopened prosecution and rejected the pending claims. Thus, the Examiner took at least eight months to issue any form of rejection of the claims. Through its Decision, the Office seeks to charge this delay to Applicants. Such a ruling is contrary to statute and law. *See e.g.,* MPEP §2731. Furthermore, it would be unfair to deny Applicants patent term adjustment for these eight months when Applicants could not have taken any action to prevent the delay and any delay was caused by the Examiner's decision to reopen prosecution. *See* MPEP §2302 (practice point three) ("In light of patent term adjustments it is no longer appropriate to suspend an application on the chance that an interference might ultimately result.")

CONCLUSION

Based on the foregoing, Applicants respectfully request reconsideration of the Office's previous determination that Applicants are entitled to only 622 days of Patent Term Adjustment. Applicants submit that they are properly entitled to a full Patent Term Adjustment of 1043 days.

If any further information is required, please call the undersigned at the number listed below. Please charge any additional feed due in connection with the filing of this paper, or credit any overpayment, to Deposit Account No. 08-3425.

Dated: December 3, 2007

Respectfully submitted,

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